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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,262	08/26/2003	Brian Harden	DOC.016DC	2074
30310	7590	07/13/2006	EXAMINER	
DIGITAL OPTICS CORPORATION 9815 DAVID TAYLOR DRIVE CHARLOTTE, NC 28262			VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 07/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/647,262	Applicant(s) HARDEN ET AL.	
	Examiner Mathieu D. Vargot	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30, 38, 41-46 and 51-60 is/are pending in the application.
- 4a) Of the above claim(s) 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30, 41-46 and 51-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/20/2006</u> | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election of Group II in the reply filed on May 2, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is noted that the preliminary amendment cancelled a number of claims originally believed to be in the case. However, in view of the election of the method, an action hereby follows on claims 15-30 and 41-60, with product claim 38 being considered to be non-elected. I.e., it is a product that can be made by methods other than that set forth in claim 15.

2. Claims 21-25 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-23, line 1, --said-- should be inserted before "selectively" and at line 2, "material from" should be deleted. In claim 24, line 2, "embossing", both occurrences, should be changed to --imprinting--. Claim 25, line 2, "imprintable" should be changed to --imprinting--. Claim 44, line 2, "embossable" should be --imprintable-- and "os" should be changed to --on--.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 57 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandor et al (see col. 9, lines 7-38 and Figure 4).

Sandor et al discloses the instant process of making optical elements by employing a master on which imprintable material is deposited, imprinting a replica of the desired optical elements on the master in the material and transferring this replica onto a support substrate. The operation of the roller master in Fig. 4 of the applied reference renders inherent that the master would be brought into contact with only a portion of the support substrate initially—ie, the peripheral portion-- followed by full contact.

4.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17, 19-26, 30, 41-45, 51, 52, 58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor et al.

The applied reference discloses the basic claimed process as set forth in paragraph 2, supra, Sandor et al essentially lacking the aspects of the elements necessarily being on a wafer level. Note that the separation of the hardened replica on the support substrate in fact forms individual elements as set forth in claim 1. It is submitted that making the elements of Sandor et al on a wafer level would merely constitute making them on a small scale and such would have been well within the skill level of the art dependent on the exact size desired for the optical elements. Providing an ant-reflective coating on the elements would have been an obvious feature in the process of the applied

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reference dependent on the exact optical effect desired. The lithographic addition or removal of material on the imprintable material would have been an obvious feature dependent on the final use for the optical product made. I.e., one of ordinary skill would have desired to do so for mounting or decorative purposes.

5. Claims 18, 27-29, 46 and 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor et al in view of Feldman et al (see Fig. 10 and col. 6, lines 40-58).

Sandor et al discloses the basic claimed method as set forth in paragraphs 3 and 4, supra, the primary reference essentially lacking the aspect of providing marks on the mold and substrate and aligning the marks using a mask aligner. This is basically taught in Feldman et al and is a conventional way in which substrates and molds are aligned in photolithographic processing. It is submitted that such would have been an obvious feature in the process of Sandor et al to ensure that the lenticules are molded where desired over the picture image.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-30, 41-46 and 51-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,610,166. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims set forth an obvious variant of that method recited in US Patent –166 and are in fact broader with respect to the formation of the master.

7.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
July 7, 2006


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

7/6/06